



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,273	05/24/2007	Jens-Uwe Busser	0119010-00171	4920
29177	7590	03/22/2010	EXAMINER	
K&L Gates LLP P.O. BOX 1135 CHICAGO, IL 60690			BEDNASH, JOSEPH A	
			ART UNIT	PAPER NUMBER
			2461	
			MAIL DATE	DELIVERY MODE
			03/22/2010 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/587,273

Applicant(s)

BUSSE ET AL.

Examiner

Joey Bednash

Art Unit

2461

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/22)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Line 3 of claim 6 includes the limitation "a crypto module for handling cryptographic functions." MPEP 2181 II states in part:

"35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language "shall be construed to cover the corresponding structure...described in the specification and equivalents thereof." "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc)."

MPEP 2181 III (B) states:

"If the corresponding structure, material or acts are described in the specification in broad generic terms and the specific details of which are incorporated by reference to another document (e.g., attachment means disclosed in U.S. Patent No. X, which is hereby incorporated by reference, or a comparator as disclosed in the IBM article, which is hereby incorporated by reference), Office personnel must review the description in the specification, without relying on any material from the incorporated document, and apply the "one skilled in the art" analysis to determine whether one skilled in the art could identify the corresponding structure (or material or acts) for performing the recited function to

satisfy the definiteness requirement of 35 U.S.C. 112, second paragraph. See *Default Proof Credit Card System, Inc. v. Home Depot U.S.A., Inc.*, 412 F.3d 1291, 75 USPQ2d 1116 (Fed. Cir. 2005) ("The inquiry under [35 U.S.C.] § 112, ¶ 2, does not turn on whether a patentee has incorporated by reference ' material into the specification relating to structure, but instead asks first whether structure is described in the specification, and, if so, whether one skilled in the art would identify the structure from that description '")."

Examiner has reviewed the disclosure of the invention for disclosure related to the structure of the claimed crypto module. The specification includes generic descriptions of function performed by the crypto module, but does not provide a description of the structure or algorithms utilized to perform the functions. Therefore applicant has not particularly pointed out nor distinctly claimed the subject matter which is considered to be the invention.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 6-12 are rejected under 35 U.S.C. 102(a) as being anticipated by Yeager et al. (US 2003/0070070 A1) hereinafter "Yeager".

Regarding claim 6, Yeager discloses a circuit arrangement (**Fig. 2b, Peer 200B**) for securing communication between network subscribers within a peer-to-peer network (**Fig. 2B, peer group 210A**), comprising:

a crypto module for handling cryptographic functions (**Para [0106]-[0108]**);

a network module (**Fig. 3, Para [0058]**) for communication with a further network subscriber (i.e. **Fig. 2B, Peer 200D**) and a server (i.e. **Para [0062]**, “client-server systems” and “Certificate Authority”) that is not within to the peer-to-peer network (**Para [0057]-[0062]**, **Para [0020]**, lines 1-4; **Para [0114]-[0115]**, **Certificate Authority**);

a first memory module comprising a plurality of memory sub-modules that store association features relating to a first network subscriber (e.g. **codat 500, Fig. 4; Fig. 5A; Para [0066]-[0072]**); and

a second memory module comprising memory sub-modules for buffering a certificate of the further network subscriber (**Figs. 10A & 10B, Para [0125]-[0126]**),

wherein the certificate of the further network subscriber is requested by another other network subscriber (**Para [0109]-[0116]**, **[0122]-[0124]**).

Regarding claim 7, Yeager teaches the circuit arrangement as claimed in claim 6, wherein the arrangement is disposed in the first network subscriber (**Fig. 3, Para [0057]**, lines 1-4; **Fig. 4; Fig. 5A; Para [0066]-[0072]**).

Regarding claim 8, Yeager discloses the circuit arrangement as claimed in claim 6, wherein the server produces the certificate that is stored in the second memory module (**Para [0113]-[0115]**, **Certificate Authority**).

Regarding claim 9, Yeager teaches the circuit arrangement as claimed in claim 8, wherein the arrangement is disposed in the first network subscriber (**Fig. 3, Para [0057], lines 1-4; Fig. 4; Fig. 5A; Para [0066]-[0072]**).

Regarding claim 10, Yeager teaches a method for securing communication between network subscribers within a peer-to-peer network, comprising:

providing cryptographic functions via a crypto module, the functions selected from the group consisting of generating a signature, authenticity check of a signature, validity check of a certificate, encrypting a confidential message to be sent, decrypting a received message (**Para [0106]-[0108], [0120]**);

communicating via a network module (**Fig. 3, Para [0058]**) with a further network subscriber (i.e. **Fig. 2B, Peer 200D**) and with a server (i.e. **Para [0062], “client-server systems” and “Certificate Authority”**) that is not within to the peer-to-peer network (**Para [0057]-[0062], Para [0020], lines 1-4; Para [0114]-[0115], Certificate Authority**);

storing association features relating to a first network subscriber in a first memory module (e.g. **codat 500, Fig. 4; Fig. 5A; Para [0066]-[0072]**);

storing a certificate of the further network subscriber in a second memory module (**Figs. 10A & 10B, Para [0125]-[0126]**); and

receiving a request by the further network subscriber for the certificate of the further network subscriber (**Para [0109]-[0116], [0122]-[0124]**).

Regarding claim 11, Yeager teaches the method as claimed in claim 10, further comprises receiving the certificate of the further network subscriber from the server prior to the storing of the certificate (**Para [0113]-[0115], Certificate Authority**).

Regarding claim 12, Yeager discloses the method as claimed in claim 11, wherein the certificate of the further network subscriber is created via the server (**Para [0113]-[0115], Certificate Authority**).

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Huitema et al. (US 2003/0056093 A1) substantially discloses methods of forming and joining peer to peer groups.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joey Bednash whose telephone number is (571)270-7500. The examiner can normally be reached on Mon-Fri 7:30 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (571)272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joey Bednash/
Examiner, Art Unit 2461
/Huy D Vu/
Supervisory Patent Examiner, Art Unit 2461